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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,465	09/05/2003	Norbert Moszner	20959/2130 (P 63013)	8449

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Nixon Peabody LLP  
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Rochester, NY 14603-1051

EXAMINER
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BUMGARNER, MELBA N

ART UNIT	PAPER NUMBER
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3732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/656,465

Applicant(s) 

MOSZNER ET AL.

Examiner

Melba Bumgamer

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by a non-fiber reinforced flexible film, as the specification teaches fibre-shaped fillers.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-6, 8, 9, 11, 16, 17, 19, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Vallittu et al. (6,197,410). Vallittu et al. disclose a flexible dental polymer film comprising polymerizable groups capable of further polymerization, which film can be shaped around a tooth and cured by polymerization (figures 1,2). The film contains an acrylate or methacrylate group. At least a part of the polymerizable groups is radically polymerizable. At least a part of the polymerizable groups is cationically polymerizable. The film can comprise an initiator, organic or inorganic fillers, polymerization inhibitors, pigments, an antibiotic, and a primer. The film is detachably held on a carrier film that is translucent. Vallittu et al. disclose a dental polymer film and an adhesive. (columns 3-6, 8-10)

5. Claims 1-6, 8, 10, 12, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Prasad et al. (6,039,569). Prasad et al. disclose a flexible dental polymer film comprising polymerizable groups capable of further polymerization, which film can be shaped around a tooth and cured by polymerization (column 5 line 14). The film contains an acrylate or methacrylate group. The film contains polyurethanes. At least a part of the polymerizable groups is radically polymerizable. At least a part of the polymerizable groups is cationically polymerizable. The film can comprise an initiator, organic or inorganic fillers, an antioxidant, a primer, and an active substance. The film has two sides and a side of the film can have a coating of primer. (columns 3-6)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. or Prasad et al. in view of Mitra et al. Vallittu et al. or Prasad et al. disclose a dental film that shows the limitations as described above; however, they do not show the initiator in microencapsulated form. Mitra et al. teach a dental polymer comprising an initiator in microencapsulated form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the film to have microencapsulated initiator in order to enhance shelf stability in view of Mitra et al.

8. Claims 14, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. Vallittu et al. disclose a dental film that shows the limitations as described above and having two sides and various examples of the film as dental tooth constructions with polymeric material coating on the side facing away from the tooth surface; however, they do not show the film side with a coating of anti-adhesive additive. It would have been obvious to one of ordinary skill in the art at the time the invention was made to call the polymeric material of Vallittu et al. an anti-adhesive as the side is not adherent. It would have been obvious to one of ordinary skill in the art to call reinforcement in the dental film fibre-shaped filler.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallittu et al. in view of Karazivan. Vallittu et al. disclose a dental film that shows the limitations as described above; however, they do not show the carrier film of an inflatable film bag. Karazivan teaches the film detachably held on a carrier film in the form of an inflatable film bag (page 12 line 27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the film of Vallittu et al. having the carrier film of Karazivan in order to better adapt the dental film to the applied surface.

#### ***Response to Arguments***

10. Applicant's arguments filed January 16, 2007 have been fully considered but they are not persuasive. The prior art show the structural limitations of the claimed article. The claimed structure is shown regardless of the prior art calling the article something other than the claimed preamble. Applicant is claiming an article of manufacture, not the process of forming the article and not the intended use of the article as argued in the remarks pertaining to Vallittu et al. and Prasad et al., respectively. Furthermore, in an article claim such language would be given little

weight. As to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For example, Mitra et al. reference is used to teach a form of the initiator that is lacking in the primary reference(s) not the article of the polymer film.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriquez can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Melba Bumgarner".

Melba Bumgarner  
Primary Examiner